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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,135	09/29/2003	Erik Monsen	F-709	2500

7590 05/02/2007
Pitney Bowes Inc.
Intellectual Property and Technology Law Dept.
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484

EXAMINER

LIU, ERIC

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/674,135		MONSEN ET AL.	
	Examiner		Art Unit	
	Eric Liou		3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. The Applicant has amended claim 1. Thus, claims 1-7 remain pending and are presented for examination.

Response to Arguments

2. The Examiner acknowledges that Pierce et al., U.S. Patent No. 6,865,558 and the present application were commonly assigned to Pitney Bowes Inc. at the time of the invention, and therefore removes the Pierce reference under 35 U.S.C. 103(c).

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "134" (Figure 2) and "152" (Figure 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. The Examiner acknowledges amended claim 1 and withdraws the previous rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 recites the limitation "the carrier fees" in line 5. There is insufficient antecedent basis for this limitation in the claim. The term "the" should be deleted from the limitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-2, 4-5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz et al., U.S. Publication No. 2002/0073040.
10. As per claim 1, Schwartz teaches a method for paying for mail to be delivered from a sender in a first country to a recipient in a second country, comprising the steps of: affixing a

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first indicia to mail for payment of carrier fees for the first country (Schwartz: Figure 7, “705” and “709” and paragraph 0059); affixing a second country indicia to the mail for payment of the carrier fees for the second country (Schwartz: Figure 7, “710” and “708”, Figure 8, “801b”, “801c”, and “801d”, paragraph 0011, “the payee of the money order represented by the indicium to be a courier (e.g., FedEx) different from the postal authority”, and paragraphs 0059 and 0061-0064 – The Examiner notes, it is basic knowledge of one skilled in the art at the time of the invention to recognize that FedEx is an international carrier that delivers mail to a second country. Thus, the Examiner interprets barcode 710 to be a second country indicia.), and debiting a meter for the payment of the carrier fees for the first country and the carrier fees for the second country (Schwartz: Figure 1 and paragraphs 0010 and 0059).

11. As per claim 2, Schwartz teaches the method of claim 1 as described above. Schwartz further teaches wherein the first indicia is a post office postal indicia (Schwartz: Figure 7, “705” and paragraph 0059).

12. As per claim 4, Schwartz teaches the method of claim 1 as described above. Schwartz further teaches wherein the first indicia is a common carrier indicia (Schwartz: Figure 7, “705” and paragraph 0059).

13. As per claim 5, Schwartz teaches the method of claim 1 as described above. Schwartz further teaches wherein the second indicia is a common carrier indicia (Schwartz: Figure 7, “710”, paragraph 0011 – the payee is FedEx, and paragraphs 0061-0064).

14. As per claim 7, Schwartz teaches the method of claim 1 as described above. Schwartz further teaches wherein the first and second indicia are affixed to mail by a personal computer meter (Schwartz: Figure 1 and paragraphs 0008 and 0023).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040.

17. As per claim 3, Schwartz teaches the method of claim 1 as described above. Schwartz further teaches a post office postal indicia (Schwartz: Figure 7, "705" and paragraph 0059): Schwartz does not teach the second indicia is a post office postal indicia.

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included the second indicia is a post office postal indicia as taught by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry.

19. As per claim 6, Schwartz teaches the method of claim 1 as described above. Schwartz further teaches the first and second indicia are affixed to mail by a personal computer meter (Schwartz: Figure 1 and paragraphs 0008 and 0023). Schwartz further teaches the use of postage meters to print postage indicia on mail pieces (paragraph 0007). Schwartz does not teach indicia are affixed to mail by a postage meter.

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included indicia are affixed to mail

by a postage meter as taught by Schwartz because the postage meter is an effective machine used in the industry to meter mail.

Conclusion

The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

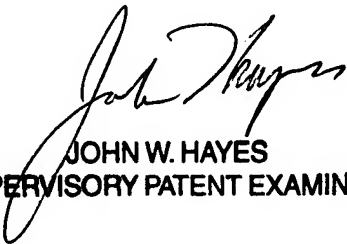
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EL


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER